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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,381	09/10/2003	Kiyoshi Miyake	S0529.0006	3331

32172 7590 10/10/2006

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NT

Office Action Summary

Application No.

10/658,381

Applicant(s)

MIYAKE, KIYOSHI

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24, 28 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24, 28 and 30-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 21 and 35, the term “bottom” with respect to the grip portion can lead to confusion with respect to which portion of the grip this is referring since there is not frame of reference (e.g., if the endoscope is turned upside down, would it still be the bottom if it is now on top?).

Furthermore, with regards to claim 35, the term “lower” as describing the portion of the bendable operation section at which the gun-shaped grip portion is provided is confusing as to which portion is “lower” (e.g., lower than what? is it lower with respect to gravity? and if it is, what if it is held upside down?). The same confusion would also apply to the term “upper” in this claim.

Additionally, as to claim 35, the term “gun-shaped” as describing the “grip portion” does not appear to be accurate since the grip portion (element 7 in Figure 3 for example) appears to be no more than “tubular” or “elongated”. Furthermore, since the term “gun-shaped” is not a

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conventional term of art, the specification fails to mention or define it, and the Examiner himself can think of many different “gun-shapes”, this term is vague and indefinite.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 21-23 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Rossoff (U.S. Pat. 5,183,031) for the reasons set forth in numbered paragraph 4 of the previous Office Action, paper number 03312006.

As previously pointed out, channel (16) opens at the distal end and has a proximal open end formed by a port (38) (forceps-port constructing member) provided on an end of the grip portion. This end (note Figure 1) of the grip portion can be considered the “bottom” as long as the endoscope is held as shown in Figure 1 (e.g., held such that the end which includes port (38) is facing downward).

4. Claims 21, 22, 24, 28 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Adair (U.S. Pat. 5,873,814) for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 03312006.

As previously noted (see col.14, lines 16-18 of the ‘814 patent), Adair refers to U.S. Pat. 5,489,256 for further description and labeling of the device shown in Figure 20 of the ‘814 patent. As see in Figure 6 of the ‘256 patent, as long as the endoscope is held the way it is

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shown, with respect to gravity, the proximal open end of the channel is “provided at the bottom of a grip end of the grip portion”.

As to claim 35, Adair further discloses that an objective lens system and CCD are contemplated at the distal end of the insertion section (best shown as 217 and 219 in Figure 16). As broadly as “gun-shaped grip” could imply, a elongated, tubular housing that is capable of fitting at least partially in a hand would appear to meet this limitation (the grip portion of the Examiner’s 9mm Smith and Wesson is elongated and tubular (e.g., rectangular, since it holds a rectangular clip) and fits within his hand). The portion (340, Fig.20) of Adair’s device is elongated, tubular and intended to have a hand fit around it.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossoff et al. in view of Ohline et al. (US 2003/0045778) and separately over Adair (‘814) in view of Ohline et al. for the reasons set forth in numbered paragraph 7 of the previous Office Action, paper number 03312006.
7. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossoff et al. in view of Ohline et al. and further in view of Suzuki et al. (U.S. Pat. 5,658,238) and separately over Adair (‘814) in view of Ohline et al. and further in view of Suzuki et al. for the

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reasons set forth in numbered paragraph 8 of the previous Office Action, paper number 03312006.

Response to Arguments

8. Applicant's arguments filed July 5, 2006 have been fully considered but they are not persuasive.

As pointed out above, both Rossoff and Adair show openings provided at a portion of the grip that can be considered the "bottom", as broadly as claimed.

Regarding new claim 35, this is addressed above with respect to Adair above. It should be noted though that if Applicant eventual claims structure directed to the disclosed shape of the grip portion and operation section (e.g. which defines grip portion/operation section as being elongated and including a longitudinal axis, one end of the elongated grip portion/operation section being connected to the proximal portion of the insertion section and extending away such that the longitudinal axis is at an angle to a longitudinal axis of the proximal portion of the insertion section, where the proximal open end of the channel is disposed on an end opposite said one end), this might overcome the Adair reference, but there potentially would be an issue of obviousness with respect to Rossoff since Rossoff discloses the structure just described. Sato is cited to show the contemplated use of a CCD and handle mounted display which the Examiner believes could apply to claim 35. Since this claim is already addressed above, this issue of obviousness will not be explored at this time.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sato (U.S. Pat. 4,604,992)—note teaching to use a display (6) to view the image in place of an optical system (ocular).

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

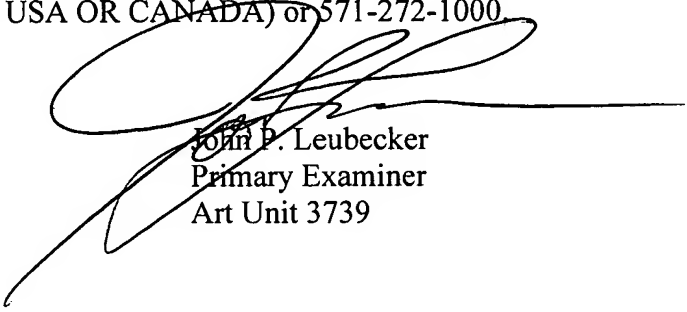
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl